IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY

NATIONAL CHRISTMAS PRODUCTS § d/b/a NATIONAL TREE COMPANY § § § **Plaintiff** Civil Action No.: 2: 17-cv-00442 § § **COMPLAINT** v. § GORDON COMPANIES, INC § § § Defendant.

COMPLAINT

National Christmas Products d/b/a National Tree Company ("Plaintiff"), for its claims against Gordon Companies, Inc. ("Defendant") alleges as follows:

I. NATURE AND SUBSTANCE OF THE ACTION

1. Plaintiff files this action against Defendant for trademark infringement, trademark dilution, and false designation of origin under the Lanham Act (15 U.S.C. §§ 1114, 1116, 1117, 1125(a) and (c)); unfair competition under N.J.S.A. § 56:4-1 et seq.; trafficking in counterfeit trademarks under N.J.S.A. § 56:3-13.16; copyright infringement under the United States Copyright Act ("DMCA") (17 U.S.C. § 501 et seq.); trademark infringement under the common law of New Jersey; and unjust enrichment under the common law of New Jersey.

II. JURISDICTION AND VENUE

- 2. This action is a civil action of which this Court has original jurisdiction under 28 U.S.C. § 1332, in that it is a civil action between citizens of different states and the matter in controversy exceeds the sum of \$75,000, exclusive of interest and costs because the Plaintiff is asking for general damages in the amount exceeding \$75,000 and the declaratory relief sought by Plaintiffs from Defendants is valued at more than the sum of \$75,000, exclusive of interests and costs.
- 3. The Court also has jurisdiction over the subject matter of this action pursuant to Section 39 of the Lanham Act, 15 U.S.C. § 1121, 17 U.S.C. § 512 (g)(3)(D), and Chapter 85 of the Judiciary and Judicial Procedure Code, 28 U.S.C. §§ 1331 and 1338, and has supplemental jurisdiction over the state law claims under 28 U.S.C. § 1367.
- 4. Venue is proper in this district pursuant to 28 U.S.C. § 1391 because Defendant transacts business within this district and offers for sale in this district products that infringe Plaintiff's trademarks. In addition, venue is proper because Plaintiff's principal place of business is in this district and Plaintiff suffered, and continues to suffer, harm in this district.

III. THE PARTIES

- 5. Plaintiff, National Christmas Products d/b/a National Tree Company, is a New Jersey corporation, having a corporate office at 2 Commerce Drive, Cranford, New Jersey 07016.
- 6. Plaintiff is informed and believes and thereupon alleges that Defendant, Gordon Companies, Inc., is a New York domestic business corporation, with its principal place of business at 85 Innsbruck Drive, Cheektowaga, New York, 14227.

IV. FACTS COMMON TO ALL CLAIMS

- 7. Plaintiff is a developer, manufacturer and distributor of high-quality seasonal and holiday-related products that are festive, beautiful and innovative. Primarily renowned for its Christmas related products, Plaintiff's holiday offerings include, but are not limited to, artificial trees, plants, figurines, lighting decorations, and accessories.
- 8. Plaintiff has allocated considerable resources and has dedicated significant effort in promoting and developing its brand. Through persistence and diligence, Plaintiff is able to offer its goods through "big box stores" such as FORTUNEOFF, HOME DEPOT, TOYS 'R US, chain stores such as BED BATH AND BEYOND, ACE HARDWARE, and internet marketplaces such as HOUZZ.com, WAYFAIR.com, and AMAZON.com. In fact, Plaintiff has achieved so much success that it has expanded its market presence throughout Canada and Europe. Being able to offer one's product through nationally and internationally recognized marketplaces adds considerable value to one's brand.
- 9. As part of its other efforts to develop its branding, Plaintiff has expended significant resources in establishing and promoting its brand identity by means of various intellectual property ("IP") endeavors. For example, by researching and developing innovative ideas, Plaintiff has been successful in procuring patent rights in artificial Christmas trees and holiday lighting.
- 10. In order to protect its business from competition, Plaintiff has acquired copyrights in photographic and design images so that such images are strongly and immediately identifiable and distinguish Plaintiff from other competitors. Plaintiff has created photographic images ("Promotional Photos") with meticulous details to lighting, angle, adornments, and other considerations so such images can be instantly recognizable as offerings by the Plaintiff. Such

images are for the sole use of the Plaintiff, and Plaintiff utilizes these images in its offering of its products through its catalog and product listings on e-commerce websites.

- trademarks. Plaintiff has secured rights in its doing-business-as name NATIONAL TREE COMPANY (Registration No. 2475045) which serves as the umbrella identifier for various Christmas offerings such as artificial Christmas trees, decorations, and novelties. Specific items can have their own (additional) trademark identifiers. One such specific moniker is DUNHILL FIR (the "Mark") for which Plaintiff has procured both common law and federally recognized trademark rights to be used with artificial Christmas trees. Common law rights were acquired at least as early as December 1, 2000 when Plaintiff utilized, promoted and marketed this Mark throughout interstate commerce within the United States (and continues to do so). To memorialize and solidify this right, Plaintiff sought federal registration for this Mark, and on June 2, 2015 Plaintiff's DUNHILL FIR mark was registered on the principal trademark register at the United States and Patent and Trademark Office ("USPTO") for use with artificial Christmas trees (Registration No. 4748103). See Exhibit A.
- 12. Pursuant to federally conferred rights, Plaintiff can and does offer its goods under both the umbrella trademark name of NATIONAL TREE COMPANY and marks specific for its particular goods, such as DUNHILL FIR, whether in conjunction with one another or separate. *See Exhibit B.*
- 13. It is upon information and belief that Defendant is in the close-out and drop ship businesses. These business models essentially involve the purchase of inventory by a "middleman" and then reselling such inventory to the general public. The close-out business model entails purchasing items that the original retailer no longer wishes to offer for sale. For

example, seasonal items have a limited window of sale, so any excess inventory is unloaded to a close-out purchaser so the original retailer may make room for the next season's products. In a drop ship business, the retailer offers goods that are not actually in its possession. Rather the drop-ship retailer fills orders by arranging for a third party (e.g. manufacturer, distributor, wholesaler) to deliver the goods to the customer.

- 14. Since as early as 1977 Defendant has been the "middleman" of various types of merchandise, but especially seasonal and Christmas-related goods. One business endeavor through which Defendant offers such goods is NORTHLIGHT (Northlightseasonal.com). *See Exhibit C and Exhibit D*. Defendant offers goods through some of the same channels as Plaintiff, for examples Amazon.com and Wayfair.com making Plaintiff and Defendant business competitors. *See Exhibit E and Exhibit F*.
- 15. Plaintiff became involved with Defendant at least as early as 2002 when, pursuant to Plaintiff's reputable status within the holiday goods industry, Defendant purchased Plaintiff's DUNHILL FIR artificial Christmas trees for resale. Plaintiff surmises that Defendant has had some success with offering Plaintiff's DUNHILL FIR artificial Christmas trees since Defendant has continued to purchase such goods from the Plaintiff.
- 16. In addition to the resale of the DUNHILL FIR artificial Christmas trees,

 Defendant has also drop shipped the same items since 2002. 1
- 17. Despite Defendant's resale and drop shipping of Plaintiff's goods, Plaintiff has never licensed or transferred any of its intellectual property rights, including trademark rights to the Mark and copyright to the Promotional Photos, to the Defendant. Further, at no point did Defendant have any authority to make use of the Mark or the Promotional Photos or permission

¹ See Exhibit L for an admission by Defendant the Defendant drop ships Plaintiff's items.

to rebrand Plaintiff's goods in connection with the Defendant's distribution and sale of similar or identical goods.

- 18. In the fall of 2016, Plaintiff became aware of Defendant's sale of artificial Christmas trees bearing the mark NORTHERN DUNHILL FIR and using the Promotional Photos belonging to and owned by Plaintiff. *See Exhibit G^2*. These offers for purchase were made on Defendant's own website Northlightseasonal.com³ as well as other sites including but not limited to Wayfair.com, Amazon.com, Walmart.com. Since Plaintiff has valid copyrights in the images and trademark rights in DUNHILL FIR, Defendant's use of Plaintiff's images and the identifier DUNHILL FIR were an unauthorized uses of Plaintiff's Mark and creative works, and such use constitutes infringement thereof.
- 19. To enforce its rights in copyright and trademark, Plaintiff delivered to Defendant two separate cease & desist letters on or about November 11, 2016. *See Exhibit H and Exhibit I*. Through such letter, Plaintiff demanded that Defendant cease and desist using Plaintiff's Promotional Photos and Mark. Further, Plaintiff demanded that Defendant remove all references of the Promotional Photos and Mark and on its site, and requested take downs of product pages on third party e-commerce sites such as Amazon.com that display the Promotional Photos, the Mark or both. In addition, Plaintiff requested a complete accounting of profits derived by the Defendant through the use of the DUNHILL FIR mark.
- 20. During the interim of awaiting for Defendant's response to the cease & desist letters, Plaintiff contacted each commercial site offering artificial Christmas trees with the

² These exhibits represent only a small sampling of the innumerous copyright and trademark infringing incidents by the Defendant.

³ The exact web address for such offerings was http://www.northlightseasonal.com/collections/artifical-christmas-trees/products/31752850. As of the filing date of this complaint, this link is no longer active and a visit to the above page displays an error page.

unauthorized use of the Mark and Promotional Photos requesting take down of the infringing products. See Exhibit J – Exhibits K.⁴

- 21. In response to the cease & desist letter, Defendant agreed to take down any infringing products and remove all references to NORTHERN DUNHILL⁵ (*rather than DUNHILL FIR*) from its sites and other e-commerce sites. In addition, Defendant dubiously claimed that it was unaware of DUNHILL FIR's status as a federally recognized trademark. No accounting of Defendant's sale of artificial Christmas trees either in monetary value or quantitative amounts were provided. *See Exhibit L*.
- 22. In addition, within the same response to the cease and desist letters Defendant admitted that it has been purchasing the goods it offers for sale from China and branding them as its own. Accordingly, it is clear that at least some of the Defendant's artificial Christmas trees do not originate from Plaintiff, yet bear the DUNHILL FIR mark.
- 23. Plaintiff hoped that the matter had finally been resolved. However, despite being notified of Plaintiff's exclusive rights to the Mark and Promotional Photos and despite a rather baffling agreement to cease use of Plaintiff's Mark (*since the agreement was to cease use of NORTHERN DUNHILL*), Defendant continues to use and offer for sale artificial Christmas trees using the Mark and Promotional Photos. *See Exhibits M Exhibits Q*⁶.
- 24. Accordingly, Defendant continues to advertise and promote goods using an identical or nearly identical Mark and Promotional Photos. The goods being offered by the Defendant bear similar or identical names and appearances as Plaintiff's Mark and Promotional

⁴ These exhibits are only a sampling of the numerous takedown requests Plaintiff had made.

⁵ It is not clear whether Defendant's acquiescence to remove the mark NORTHERN DUNHILL was a clerical error or a means of avoiding admission of guilt since the Mark at issue is DUNFILL FIR.

⁶ These exhibits represent only a sample of Defendants impermissible and unauthorized use of Plaintiff's Mark.

Photos and also constitute a reproduction or imitation thereof which causes confusion to consumers.

- 25. Further, even after supposedly agreeing to cease its infringing actions, Defendant has continued to sell product in packaging using he Mark. At least at late of December 8, 2016, Defendant was shipping product in packaging that has the Mark prominently displayed on it. *See, Exhibit R.* The product contained inside such packaging was not from the Plaintiff, and therefore constitutes a counterfeit good.
- 26. The Defendant's unauthorized use of DUNHILL FIR is a misappropriation of the Mark, which dilutes the distinctiveness and associated goodwill of Plaintiff's Mark.
- 27. If Defendant is not enjoined from continued use of the Mark and Promotional Photos, Plaintiff has and will continue to suffer irreparable injury subject to further dilution of the distinctiveness of the Mark and usurping of Plaintiff's brand.

V. FIRST CAUSE OF ACTION

Federal Trademark Infringement under 15 U.S.C. § 1114

- 28. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-27 of this Complaint as if fully set forth herein.
- 29. Plaintiff's Mark is inherently distinctive, arbitrary and suggestive, and has acquired secondary meaning. The public associates the Mark exclusively with Plaintiff's artificial Christmas trees. This is a result of the extensive promotion and use of the Mark by Plaintiff in interstate commerce. Plaintiff's Mark is further subject to a federal registration (US Trademark Registration No. 4748103).

- 30. Defendant admittedly used Plaintiff's Mark in the commercial offerings of its artificial Christmas trees of similar or identical nature to those of Plaintiff.
- 31. Upon information and belief, Defendant have acted with knowledge of Plaintiff's ownership of the Mark and with deliberate intention or willful blindness to unfairly benefit from the incalculable goodwill symbolized thereby.
- 32. Defendant's actions in connection with the misuse were unauthorized and unlawful actions that constitute a reproduction, counterfeit, copy, or colorable imitation of the Mark. By committing the acts alleged herein, Defendant has intentionally, knowingly, and willfully infringed Plaintiff's Marks in violation of 15 U.S.C. §1114.
- 33. Upon information and belief, Defendant has made and will continue to make substantial profits and gains to which it is not in law or equity entitled.
- 34. Upon information and belief, Defendant intends to continue its infringing acts unless restrained by this court.
- 35. Plaintiff has suffered harm for which there is not an adequate remedy at law, unless Defendant is permanently enjoined by this Court from using the Mark.
- 36. As a direct and proximate result of Defendant's infringing acts, Plaintiff has suffered damages in an amount that will be established at trial.

VI. SECOND CAUSE OF ACTION

Federal Trademark Counterfeiting Under 15 U.S.C. § 1114

37. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-36 of this Complaint as if fully set forth herein.

- 38. Defendant, without authorization of Plaintiff, has used and are continuing to use counterfeit marks or spurious designations that are identical to, or substantially indistinguishable from, the Plaintiff's Mark.
- 39. The foregoing acts of Defendant are intended to cause, have caused, and are likely to continue to cause confusion or mistake, or to deceive consumers, the public, and the trade into believing that Defendant's infringing goods are genuine or authorized products of Plaintiff.
- 40. Upon information and belief, Defendant has acted with knowledge of Plaintiff's ownership of the Marks and with deliberate intent or willful blindness to unfairly benefit from the incalculable goodwill inherent in the Marks.
- 41. Defendant's acts constitute trademark counterfeiting in violation of Section 32 of the Lanham Act (15 U.S.C. § 1114).
- 42. Upon information and belief, Defendant has made and will continue to make substantial profits and gains to which they are not in law or equity entitled.
- 43. Upon information and belief, Defendant intends to continue their infringing acts unless restrained by this court.
- 44. As a direct and proximate result of Defendant's infringing acts, Plaintiff has suffered damages in an amount that will be established at trial.

VII. THIRD CAUSE OF ACTION

Trademark Dilution Under 15 U.S.C. § 1125(c)

45. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-44 of this Complaint as if fully set forth herein.

- 46. The Mark is famous within the meaning of 15 U.S.C. §1125(c) and is inherently distinctive and has acquired distinctiveness. The Mark is used in a variety of context, but most prominently used in connection with Plaintiff's Christmas-themed products, including artificial Christmas tree. Plaintiff has been using the Mark to promote artificial Christmas trees through the advertisement, distribution and sale thereof since at least December 1st 2000. Therefore, based on approximately seventeen (17) years of extensive use of the Mark across various forms of media, including, but not limited to, print and internet media and advertisements, Plaintiff's Mark has acquired famous status.
 - 47. Plaintiff has extensively and exclusively used the Mark in interstate commerce.
- 48. Defendant's actions in connection with the misuse have caused irreparable injury to Plaintiff by diluting the Mark's distinctive quality in violation of 15 U.S.C. §1125(c). Defendant's use of the Mark has diluted the distinctive quality of the Mark and diminished the power of the Mark to identify and distinguish Plaintiff's goods.
- 49. As a direct result of Defendant's misappropriation of the Mark, Plaintiff has suffered irreparable harm to the value of the Mark. The acts complained of herein constitute trademark dilution in violation of 15 U.S.C. § 1125(c).
- 50. Plaintiff has suffered irreparable harm for which there is not an adequate remedy at law, unless Defendant is permanently enjoined by this Court from using the Mark.
- 51. As a direct and proximate result of Defendant's unlawful acts, Plaintiff has suffered damages in an amount that will be established at trial.

VIII. FOURTH CAUSE OF ACTION

False Designation of Origin 15 U.S.C. § 1125(a)

- 52. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-51 of this Complaint as if fully set forth herein.
- Defendant has knowingly used the Mark in connection with the products that Defendant promotes and sells. Defendant's acts in connection with the misuse are likely to confuse, mislead, or deceive the consuming public as to origin, source, sponsorship, or affiliation of Defendant's products and services, and are likely to cause such persons to believe in error that Defendant's products and services have been authorized, sponsored, endorsed, approved, or licensed by Plaintiff.
- 54. Defendant's acts constitute false or misleading descriptions, false advertising, and false designations of the origin of Defendant's goods and services in violation of 15 U.S.C. § 1125 (a). As a result, Plaintiff has suffered irreparable harm to value of the Mark.
- 55. Plaintiff has suffered irreparable harm as a result of Defendant's misuse of the Mark for which there is not an adequate remedy at law, unless Defendant is permanently enjoined by this Court from using the Mark.
- 56. As a direct and proximate result of Defendant's unlawful acts, Plaintiff has suffered damages in an amount that will be established at trial.

IX. FIFTH CAUSE OF ACTION

Common Law Trademark Infringement

- 57. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-56 of this Complaint as if fully set forth herein.
- 58. Plaintiff was the first to use the Mark in connection with artificial Christmas trees. As a result, Plaintiff owns all rights, title, and interest in and to the Mark, including all common law rights in such marks.
- 59. Defendant's unauthorized use of the Mark in connection the misuse detailed herein constitutes trademark infringement in violation of the common law of the State of New Jersey.
- 60. Defendant's acts complained of herein were done with full knowledge and intentional disregard for Plaintiff's rights in the Mark. Defendant's acts have caused confusion in New Jersey as to the source of Defendant's goods and services.
- 61. By reason of Defendant's actions, Plaintiff has suffered irreparable harm for which there is not an adequate remedy at law, unless Defendant is permanently enjoined by this Court from using the Mark.
- 62. As a direct and proximate result of Defendant's unlawful acts, Plaintiff has suffered damages in an amount that will be established at trial.

X. SIXTH CAUSE OF ACTION

Unfair Competition under N.J.S.A. §56:4-1 et seq.

- 63. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-62 of this Complaint as if fully set forth herein.
- 64. Defendant simulated Plaintiff's Mark and artificial Christmas trees and substituted Defendant's products for those of Plaintiff, thereby deceiving and misleading the public.
- 65. The actions of the Defendant's in connection with the misuse of Plaintiff's Mark constitute unfair competition as a matter of New Jersey common law.
- 66. As a result of Defendant's actions, Plaintiff has suffered damage to its reputation and loss of business due to Defendant's unfair practices.
- 67. By reason of Defendant's actions, Plaintiff has suffered irreparable harm for which there is not an adequate remedy at law, unless Defendant is permanently enjoined by this Court from using the Mark.
- 68. As a direct and proximate result of Defendant's unlawful acts, Plaintiff has suffered damages in an amount that will be established at trial.

XI. SEVENTH CAUSE OF ACTION

Copyright Infringement under 17 U.S.C. §501

- 69. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-68 of this Complaint as if fully set forth herein.
- 70. Plaintiff's Promotional Photos were created by or on behalf of the Plaintiff. Such images were reproduced identically and marketed in conjunction with Defendant's unlawful and impermissible use of Plaintiff's Mark.
- 71. Defendant's actions in connection with the use, copying, reproduction and publication of the Promotional Photos were unauthorized and unlawful actions that constitute a reproduction, counterfeit, copy, or colorable imitation of the Promotional Photos. By committing the acts alleged herein, Defendant has intentionally, knowingly, and willfully infringed Plaintiff's copyrights in the Promotional Photos in violation of 17 U.S.C. §501.
- 72. Plaintiff has suffered harm for which there is not an adequate remedy at law, unless Defendant is permanently enjoined by this Court from using the Promotional Photos.
- 73. As a direct and proximate result of Defendant's infringing acts, Plaintiff has suffered damages in an amount that will be established at trial.

XII. EIGHTH CAUSE OF ACTION

Trademark Counterfeiting under N.J.S.A § 56:3-13.16 17 U.S.C. §501

- 74. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-73 of this Complaint as if fully set forth herein.
- 75. Defendant has used, without Plaintiff's consent, reproductions, counterfeits, copies or colorable imitations of Plaintiff's Marks in connection with the sale, distribution,

offering for sale or advertising of the Defendant's infringing products, which are likely to cause confusion, mistake or to deceive consumers, the public or the trade as to their source or origin.

- 76. The foregoing acts of Defendant constitutes trademark counterfeiting in violation of N.J.S.A. § 56:3-13.16.
- 77. Upon information and belief, Defendant has made and will continue to make substantial profits and gains to which it is not in law or equity entitled.
- 78. Upon information and belief, Defendant intends to continue its infringing acts unless restrained by this court.
- 79. Plaintiff has suffered harm for which there is not an adequate remedy at law, unless Defendant is permanently enjoined by this Court from using the Mark.
- 80. As a direct and proximate result of Defendant's infringing acts, Plaintiff has suffered damages in an amount that will be established at trial.

XIII. SEVENTH CAUSE OF ACTION

Unjust Enrichment

- 81. Plaintiff re-alleges and incorporates by reference each and every allegation of paragraphs 1-80 of this Complaint as if fully set forth herein.
- 82. The acts complained of above constitute Defendant's unjust enrichment at Plaintiff's expense, in violation of the common law of the State of New Jersey.

XIV. PRAYER OF RELIEF

WHEREFORE, Plaintiff requests that judgment be entered in its favor against Defendant as follows:

- a. Finding that Defendant's unauthorized use of the Mark infringes Plaintiff's intellectual property rights;
 - b. Finding that Defendant's unauthorized use of the Mark dilutes Plaintiff's Mark;
- c. Finding that Defendant's unauthorized use, reproduction, and copying of the Promotional Photos infringe Plaintiff's intellectual property rights;
- d. Finding that (i) Defendant has violated Section 32 of the Lanham Act (15 U.S.C. § 1114), Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)) and Section 43(c) of the Lanham Act (15 U.S.C. § 1125(c)); (ii) Defendant has violated Section 501 of the Copyright Act of 1976 (17 U.S.C. § 501); (iii) Defendant has trafficked in counterfeit marks in violation of N.J.S.A. § 56:3-13.16 (iv) Defendant has engaged in unfair competition in violation of N.J.S.A. § 56:4-1 et seq.; (v) Defendant has engaged in trademark infringement in violation of New Jersey common law; and (vi) Defendants have been unjustly enriched in violation of New Jersey common law;
- e. Preliminarily and permanently enjoining Defendant, its successors, officers, agents, and employees, and anyone acting in concert with or acting at the direction of any of them from, pursuant to Rule 65 of the Federal Rules of Civil Procedure, 15 U.S.C. § 1116, 17 U.S.C. § 502, N.J.S.A. § 56:3-13.16(d) and N.J.S.A. § 56:4-2:
 - (1) Using the Mark or any confusingly similar designation, in connection with the promotion, advertising, or sale of the Defendant's goods and services;

- (2) Using, reproducing, copying, publishing the Promotional Photos or any derivate work in connection with the promotion, advertising or sale of the Defendant's goods and services;
- (3) Doing any other act that is likely to confuse or mislead others into believing that the Defendant, or its goods or services, are approved by or associated with Plaintiff;
- (4) Competing unfairly with Plaintiff in any manner, including unlawfully using any marks that are confusingly similar to Plaintiff's Mark and/or the Promotional Photos; and
- (5) Conspiring, aiding, or abetting, any other person or entity from performing any of the activities referred to in subparagraphs (1)-(4) above.
- f. Ordering that all labels, signage, prints, advertisements, accessories, and any other materials in Defendant's possession or control that depict or make reference to the Mark and/or the Promotional Photos or any imitation thereof be destroyed, and the Mark, Promotional Photos, and any imitation thereof be removed from all Internet websites, online advertising; marketing, searching engines, or other online materials pursuant to 15 U.S.C. § 1118 and 17 U.S.C. § 503;
- g. Ordering any such other relief as the Court may deem appropriate to prevent the trade and public from deriving the erroneous impression that any service or product manufactured, sold, or otherwise circulated or promoted by Defendant is authorized by Plaintiff or related in any way to Plaintiff's products or services.
- h. Ordering Defendant to file with Court and serve on Plaintiff, within 30 days after the entry and service of this injunction, a written report, sworn under oath, setting the forth the manner and form in which Defendant has complied with the injunction.

i. Awarding Plaintiff compensation for all damages and harm it has sustained as a

result of Defendant's infringement, dilution and unfair competition in connection with the

trademark and copyright misuses.

į. Awarding Plaintiff treble damages resulting from Defendant's willful and

intentional conduct pursuant to 15 U.S.C. § 1117 and New Jersey law;

Awarding Plaintiff actual damages and profits and statutory damages resulting k.

from Defendant's impermissible and unauthorized conduct pursuant to 17 U.S.C. § 504;

1. Assessing and awarding Plaintiff its attorneys' fees and costs incurred in this

action against Defendant pursuant to 15 U.S.C. § 1117, 17 U.S.C. § 504 and New Jersey law;

and

Ordering or awarding any other relief that the Court deems just and proper. m.

JAMES M SMEDLEY LLC

A Limited Liability Company Attorneys for Plaintiff, National Christmas

Products, d/b/a National Tree Company

Respectfully submitted,

/S/ James M. Smedley

james.smedley@sigmalawgroup.com

James M. Smedley, Esq.

Honeah Mangione, Esq.

Dated: January 23, 2017

DEMAND FOR JURY TRIAL

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff requests a trial by jury.

JAMES M SMEDLEY LLC

A Limited Liability Company Attorneys for Plaintiff, National Christmas Products, d/b/a National Tree Company

Respectfully submitted,

By: <u>/S/ James M. Smedley</u> james.smedley@sigmalawgroup.com

James M. Smedley, Esq. Honeah Mangione, Esq.

Dated: January 23, 2017

L.CIV.R. 11.2 CERTIFICATION

The undersigned certifies that the matter in controversy in the within action is not the subject of any other action pending in any court or of any pending arbitration or administrative proceeding.

JAMES M SMEDLEY LLC

A Limited Liability Company Attorneys for Plaintiff, National Christmas Products, d/b/a National Tree Company

Respectfully submitted,

By: <u>/S/ James M. Smedley</u> james.smedley@sigmalawgroup.com

James M. Smedley, Esq. Honeah Mangione, Esq.

Dated: January 23, 2017

Exhibit A

Anited States of America Muitah States Patent and Arahemark Office United States Patent and Trademark Office

Dunhill Fir

Reg. No. 4,748,103 NATIONAL CHRISTMAS PRODUCTS, INC. (NEW JERSEY CORPORATION), DBA

NATIONAL TREE COMPANY Registered June 2, 2015 2 COMMERCE DRIVE CRANFORD, NJ 07016

Int. Cl.: 28

FOR: ARTIFICIAL CHRISTMAS TREES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

TRADEMARK FIRST USE 12-1-2000; IN COMMERCE 12-1-2000.

PRINCIPAL REGISTER THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-TICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FIR", APART FROM THE

MARK AS SHOWN.

SER. NO. 86-460,459, FILED 11-20-2014.

BARBARA BROWN, EXAMINING ATTORNEY



Michelle K. Zen Director of the United States Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years* What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.* **See** 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods* What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*ATTENTION MADRID PROTOCOL REGISTRANTS: The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see http://www.wipo.int/madrid/en/.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at http://www.uspto.gov.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at http://www.uspto.gov.

Exhibit B

FREE SHIPPING ON ORDERS OVER \$29 details IN STORE PICKUP details

COLLEGE

TRENDS & IDEAS

PRODUCTS

Tind A Store You May Like... My Offers Track Order Contact Us Giff Cards

Ship To

Q

Home > Holiday > Christmas > Christmas Trees > National Tree Dunhill Fir Christmas Tree Collection > National Tree Company 4.5-Foot Dunhill Fir Pre-Lit Christmas Tree with Clear Lights

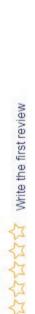
What can we help you find? > | V WEDDING & GIFT REGISTRY

National Tree Company 4.5-Foot **Dunhill Fir Pre-Lit Christmas Tree** with Clear Lights The Dunhill Fir Pre-Lit Christmas Tree with Clear Lights from National Tree treasured ornaments. Hinged branches make set-up quick and easy, year looks and feels fresh-from-the-forest real, perfect for displaying your after year.

Vendor Shipping Details Gift Packaging Unavailable



Part of the National Tree Dunhill Fir Christmas Tree Collection Collection









\$129.99

4.5 FT Size

Must order by 12/15 to guarantee delivery by 12/24. Free Shipping on Orders Over \$29

ADD TO REGISTRY

ADD TO CART



Exhibit C

INORTHLIGHT

(B) (C) (C)





Login | Request an Account



Q Search

Christmas & Holiday » Spring & Everyday » Everything Else Contact Us Blog



Like 0

▼ Tweet

+5

Order Summary

Your Cart is empty

Northlight is a manufacturing, importing and wholesale division of the family owned and operated Gordon Companies Inc.

About Us

Home » About Us

and gift decor. This includes holiday accessories, patio furniture, lawn and garden necessities, and pool and spa equipment. Northlight, which has showrooms in Atlanta, GA, Las Vegas, NV, and Buffalo, NY, offers an extensive variety of seasonal

Northlight-branded items can be found in boutique retailers across the U.S. As a family-owned company, we have nearly 40 years of retail and wholesale experience. We take pride in offering the highest quality products at the lowest possible prices.

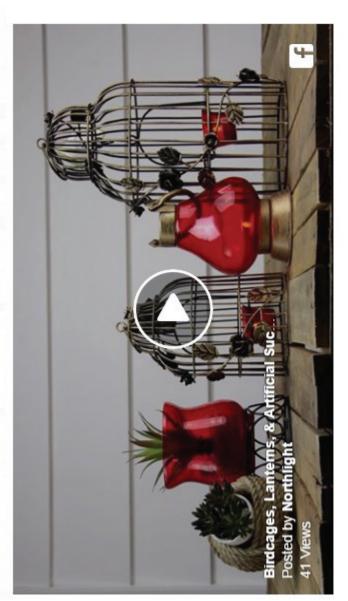


Exhibit D

Exhibit E



12/9/2016

dunhill fir christmas tree

Amazon.com: Northlight Seasonal Unlit Northern Dunhill Fir Full Artificial Christmas Tree, 6.5: Home & Kitchen

12 DAYS OF DEALS Philips Sonicare

Orders Try Prime •

Hello. Sign in **Account & Lists →**

Cart

Heating & Cooling

Vacuums & Floor Care ▼

Storage *

Artwork •

Home Décor ▼

Bedding & Bath

Shop by Room

Best Sellers

Home & Kitchen

Today's Deals

Your Amazon.com

Departments -

Back to search results for "dunhill fir christmas tree"



Northlight Seasonal Unlit Northern **Dunhill Fir Full Artificial Christmas**

Tree, 6.5'

Be the first to review this item by Northlight Seasonal

Price: \$155.99 + \$5.00 shipping

In Stock.

Arrives before Christmas.

Get it as soon as Dec. 13 - 16 when you choose Expedited

Shipping at checkout.

Ships from and sold by Pool and Patio Decor.

Item #: 31450614

Product Weight: 44 lbs

Dimensions: 50x78x50

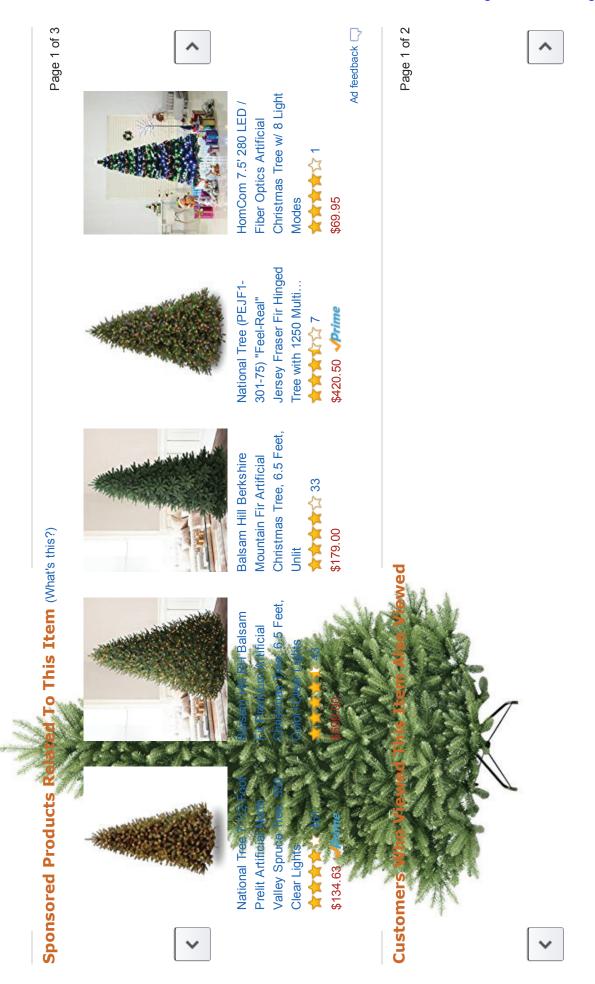
New (2) from \$155.99 + \$5.00 shipping

In Stock. Sold by Pool and Patio 1-Click ordering is not available for \$155.99 + \$5.00 shipping e Add to Cart this item. Oty: 1 Decor WARREN, NJ 07059 Share 🔽 Add to List Ship to: <u>ز</u>



Have one to sell?

Sell on Amazon



Amazon.com: Northlight Seasonal Unlit Northern Dunhill Fir Full Artificial Christmas Tree, 6.5: Home & Kitchen







Amazon.com: Northlight Seasonal Unlit Northern Dunhill Fir Full Artificial Christmas Tree, 6.5: Home & Kitchen

12/9/2016

Classic Pine Full Unlit Christmas Tree

National Tree Dunhill Fir Hinged Tree, 7-Feet

National Tree DUH-75 7.5-Artificial Christmas Tree feet Dunhill Fir Hinged \$189.00 **Include**

Christmas Tree, 6.5 Feet National Tree DUH-65 **Dunhill Fir Hinged**

Hinged Artificial Christmas Tree W/ 550 Clear Lights... Best Choice Products 7.5' Ft Prelit Premium Spruce \$119.99

\$199.99

Customers Viewing This Page May Be Interested In These Sponsored Links (What's this?)

- **Dunhill Fir Christmas Tree Sale Up** to 50% off + Free Shipping 🗗
- Artificial Christmas Trees Save Up TA EAO A E ENA Chinaina Ja 2
- (What's this?)
 www.hayneedle.com/ChristmasTrees/DunhillFirm
 no
 on
 the com/Since-1976
 The com/Since-1976 Huge Selection of Dunhill Fir Christmas Tree. Shop Online Exclusives Now!
 - The The Trainted Brend Cince 10761 World's Finest Artificial Christmas

Ad feedback

Special Offers and Product Promotions

• Your cost could be \$105.99 instead of \$155.99! Get a \$50.00 gift card instantly upon approval for the Amazon.com Rewards Visa Card. Apply now.

Product Description

Features perfectly shaped tapered tips that are a medium green color and have a natural. Iush look and feel. Product Features: Unlit. 1838 tips. 1.75" wide tips. Full profile tree. Flame retardant. Hinged branch construction. For indoor use only. Comes with a FREE black metal tree stand. Dimensions: 6.5' high (from the base of stand to the top of the tree). 50" base diameter (at the widest point). Material(s): PVC/metal

Product Information

Page 1 of 7

	Product Warranty: For warranty information about this product, please click here Feedback		Would you like to give feedback on images? Would you like to tell us about a lower price?		(u		
))	44 pounds	34 pounds (View shipping rates and policies)	NORHTLIGHT	B00ZASOS96	31450614	Be the first to review this item 0.0 out of 5 stars	#2,983,037 in Home and Kitchen (See Top 100 in Home and Kitchen)
)	Item Weight	Shipping Weight	Manufacturer	ASIN	Item model number	Customer Reviews	Best Sellers Rank

Amazon.com: Northlight Seasonal Unlit Northern Dunhill Fir Full Artificial Christmas Tree, 6.5: Home & Kitchen

12/9/2016

Sponsored Products Related To This Item (What's this?)





Christmas Tree, 7.5 feet,

全中中中公33 Clear Lights

\$289.00

Balsam Hill Berkshire Mountain Fir Artificial



Christmas Tree, 6.5 Feet, Balsam Hill BH Balsam Fir Premium Artificial Color+Clear Lights क्षेत्रक्षेत्र ४३ \$599.00



Balsam Hill Classic Blue Christmas Tree, 7 Feet, Spruce Narrow Artificial Unlit





Christmas Tree 7' with Canadian Fir Grande 300 Clear Lights 本本本本公公5



Ad feedback

\$229.00

\$134.63 **Institute**

Customer Questions & Answers

Q Have a question? Search for answers

Christmas Morning

Capri Boulevard

Country Cabin

Beach Day

Northlight Seasonal | Wayfair

Registry

Departments ~

Rooms

Inspiration

Sale

Northlight

Q

Browse By Brand > Northlight Seasonal

Northlight Seasonal

Categories

Northlight Seasonal Holiday Lighting

Ornaments & Tree Décor

Northlight Seasonal

Christmas Stockings & Tree Northlight Seasonal Skirts

Northlight Seasonal

Northlight Seasonal Holiday Figurines & Collectibles Garlands & Swag

Northlight Seasonal Accent Outdoor Decorations Northlight Seasonal

Northlight Seasonal Accent Pillows Chairs

Northlight Seasonal Air Mattresses Northlight Seasonal Area

Northlight Seasonal

Northlight Seasonal Baking Craft Supplies

Dishes

Northlight Seasonal Art &

Northlight Seasonal Baskets, Boxes & Buckets

Northlight Seasonal Bean Northlight Seasonal Beverage Servers

Ornaments & Tree Décor Northlight Seasonal (928) Northlight Seasonal Bird

As a family-owned company, Northlight has nearly 40 years of retail and wholesale innovative designs and to search for and import products with their customers experience. They believe the cornerstone to their mutual success is to provide foremost in mind. NORTHLIGHT

Browse Collections from Northlight Seasonal

Basic Luxury	
Autumn	
Alpine Chic	

Candy Lane **Botanic Beauty**

Diva Safari

Christmas Traditions

Fancy Fair

City Chic

+ Show All Collections

Gingerbread Kisses

French Countryside

Country Heritage



Holiday Lighting (227) Northlight Seasonal



Christmas Stockings & **Northlight Seasonal** Tree Skirts (254)



Garlands & Swag (205) Northlight Seasonal



Northlight Seasonal Holiday Figurines & Collectibles (631)

Northlight Seasonal Candles

Northlight Seasonal

Canisters & Jars

Northlight Seasonal Cat

Condos & Cat Trees

Northlight Seasonal Cat

Litter Box Accessories

Northlight Seasonal Candle

Holders

Camping Lanterns &

Lighting

Northlight Seasonal



Northlight Seasonal (280)

Christmas Trees (416)

Northlight Seasonal

Northlight Seasonal Wreaths (290)



Outdoor Decorations

Holiday Accents & Decor

(185)

Northlight Seasonal Coat

Racks and Hooks

Northlight Seasonal

Christmas Trees

Christmas Tree Stands &

Accessories

Northlight Seasonal

Northlight Seasonal Coolers

Northlight Seasonal Cove

Lighting

Northlight Seasonal



Northlight Seasonal Wall



Candle Holders (265) Northlight Seasonal





Shiny Wrought Iron Lantern More Options: Color » by Northlight Seasonal





Outdoor Accents (198) Northlight Seasonal Garden Statues &

Art (108)



Northlight Seasonal Cupolas

& Weathervanes

Daybeds, Guest Beds &

Folding Beds

Northlight Seasonal

Decorative Boards

Northlight Seasonal

Northlight Seasonal Decorative Objects

Decorative Trays

Northlight Seasonal

Northlight Seasonal Cruets

& Condiment Bottles

More Options: Color » by Northlight Seasonal Umbrella

Indoor/Outdoor Wall Country Rustic Star

Northlight Seasonal Dining

Northlight Seasonal Dining

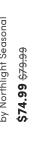
Northlight Seasonal Dog

Beds & Mats

More Options »

by Northlight Seasonal

rom \$10.00 \$14.99





\$5.99

FREE Shipping

https://www.wayfair.com/Northlight-Seasonal-B36938.html?rtype=12&redir=Northlight

Northlight Seasonal Bird

Feeders

Northlight Seasonal

Birdhouses

Northlight Seasonal

Bouncers

8

https://www.wayfair.com/Northlight-Seasonal-B36938.html?rtype=12&redir=Northlight

Northlight Seasonal Folding Northlight Seasonal Floor Northlight Seasonal Faux Northlight Seasonal Dog Crates/Kennels/Carriers Northlight Seasonal Faux

Plants and Trees

Florals

100 Light Mini Halloween or More Options: Color » by Northlight Seasonal Christmas Light

Northlight Seasonal Garden

Northlight Seasonal

Chairs

Furniture Cushions

Statues & Outdoor Accents

Glassware & Barware

Northlight Seasonal

Hammocks

Northlight Seasonal

\$8.99 \$12.99

Northlight Seasonal Holiday

Accents & Decor

Northlight Seasonal Holiday

Decor Storage



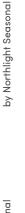
Pumpkin with Sunflowers Autumn Harvest Artificial by Northlight Seasonal

Lighted Rustic Lodge Fireplace

Battery Operated 8 LED



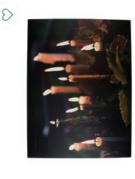
Autumn Harvest Artificial Pumpkin with Mixed Fall by Northlight Seasonal



\$10.99

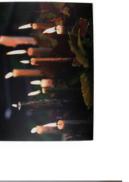


\$26.99



Lighted Candle and Leaves Battery Operated 6 LED by Northlight Seasonal





\$9.99

\$23.99 \$25.99





Northlight Seasonal Judaica

Northlight Seasonal Kids

Chairs

Northlight Seasonal Kids

Tables and Sets

Northlight Seasonal Indoor

& Outdoor Fountains

Northlight Seasonal Hot

by Northlight Seasonal

Northlight Seasonal Kitchen

Aprons

Landscape Lanterns &

Forches

Northlight Seasonal

Northlight Seasonal

\$14.99

Northlight Seasonal Lawn

and Beach Chairs

Landscaping Accessories

Northlight Seasonal Landscape Lighting



Northlight Seasonal Mats

Northlight Seasonal Light

12/9/2016

Exhibit G

Dunhill Fir 7.5' Hinged Green Artificial Christmas Tree and Strong Brane Strong Bra Stand by National Tree Co.

**** 99 Reviews | Ask the First Question

\$187.99 \$329.99 43% Off

Payments as low as \$17/month. Learn More

FREE Shipping

Expected back in stock by Jun 17, 2017.

Notify Me

Save to Idea Board

You Might Also Need

* Wayfair Departments



12/5/2016 Case 2:17-cv-00442Ngthlights@Northenologybrub FingFull Attitle (a) C1/209/157 ree Pout to be 1 Vot fall Page ID: 41 Free Shipping Over \$49* | Up to 70% OFF 72 Hour Sale » Registry Idea Boards Account ***Wayfair*** Departments ~ Q Rooms ~ Inspiration Sale Categories Northlight 6.5' Northern Innsbruk Pine Full Artificial All Christmas Trees Christmas Tree Pre-Lit Christmas Trees Flocked Christmas Trees 3.5 (2 Reviews) Christmas Trees With Stands HOT DEAL! Upside Down Christmas Trees \$149.99 **FREE Shipping** Potted Christmas Trees Real Christmas Trees Get it by Thu, Dec 15 List Price: \$174.99 White Christmas Trees You Save: \$25.00 (14%) Get It Fast Add to Cart ▶ Full Details Express Shipping Zip Code: 06831 change Tree Height Less than 3' 3' - 6' 1 - 48 of 2,193 results Sort: Recommended 6' - 7' 7' - 8' 8' - 10' \Diamond 10' - 12' Shape Regular (Full) Slender Extra Full Upside Down 6' Pre-Lit Sequoia Tree with Pop Up 6' Green Artificial More Options: Lights » Pure White Lights Christmas Tree with 350 Lights North Valley Spruce 7.5' Tree Flatback and Quarter by Queens of Christmas by LB International by National Tree Co. Spiral-Shaped \$269.99 \$95.99 \$192.41 \$229.99 Price Per Item **FREE Shipping FREE Shipping FREE Shipping** Under \$100 **★★★★** (8) ★★★★★ (31) **★★★★★** (4) \$100 to \$250 \$250 to \$500 \Diamond \$500 to \$750 \$750 to \$1,000 \$1.000 & Above Min to 299 Size Small Medium 3' Green Pine Artificial Innsbruk Pine 6.5' Hinged Kingswood 3" Green Fir Large Christmas Tree with 50 Pre-Lit Green Artificial Christmas Tree Artificial Christmas Tree by National Tree Co. by National Tree Co. by National Tree Co. Mini

\$253.99

FREE 1-Day Shipping

\$32.99

★★★★★ (29)

\$65.99

FREE Shipping

Bulb Type



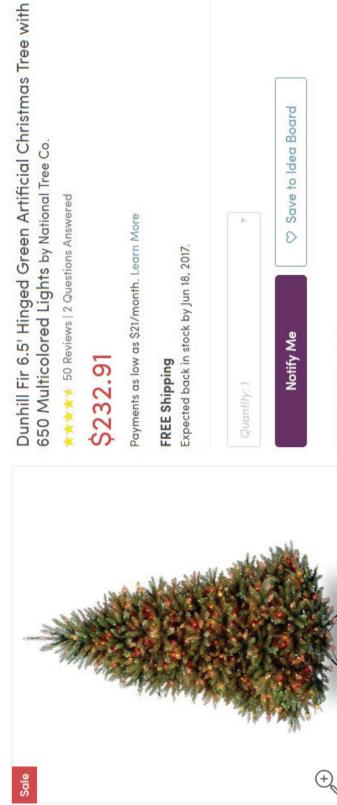
Find anything for your home...

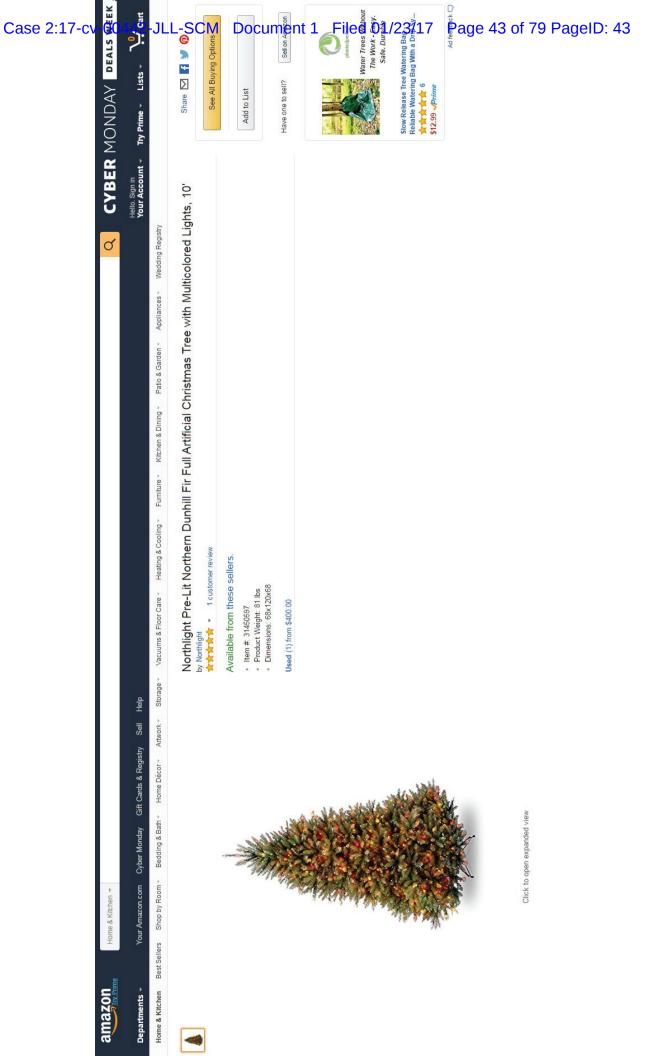
Sale

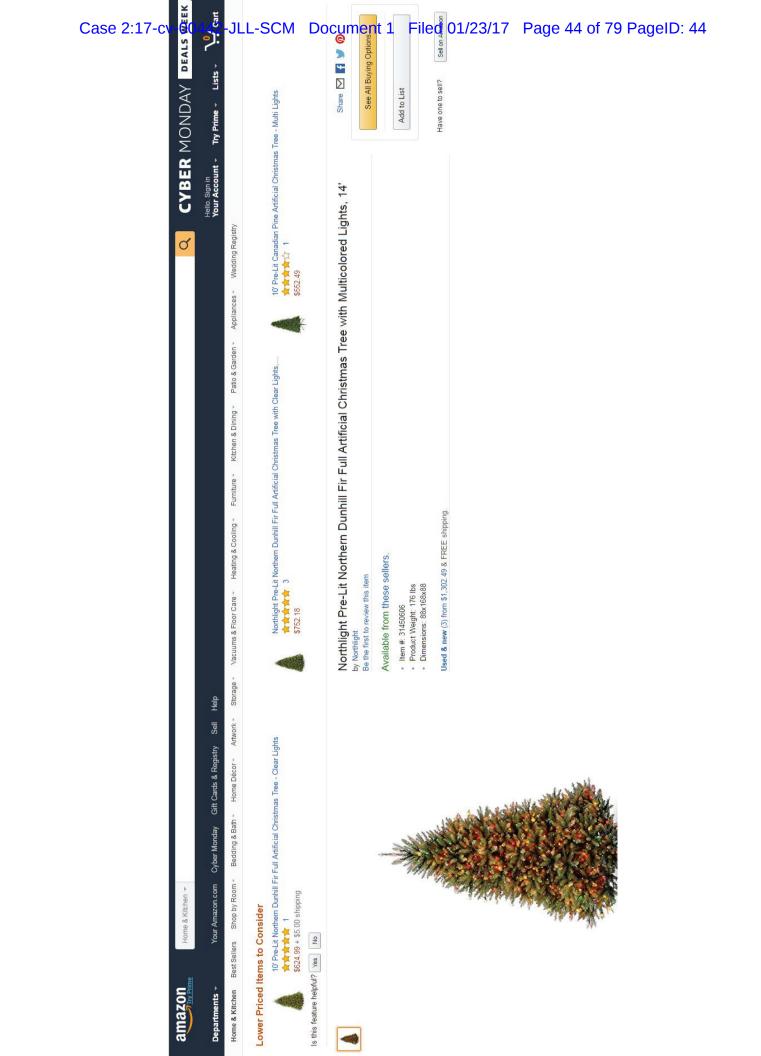
Rooms - Inspiration

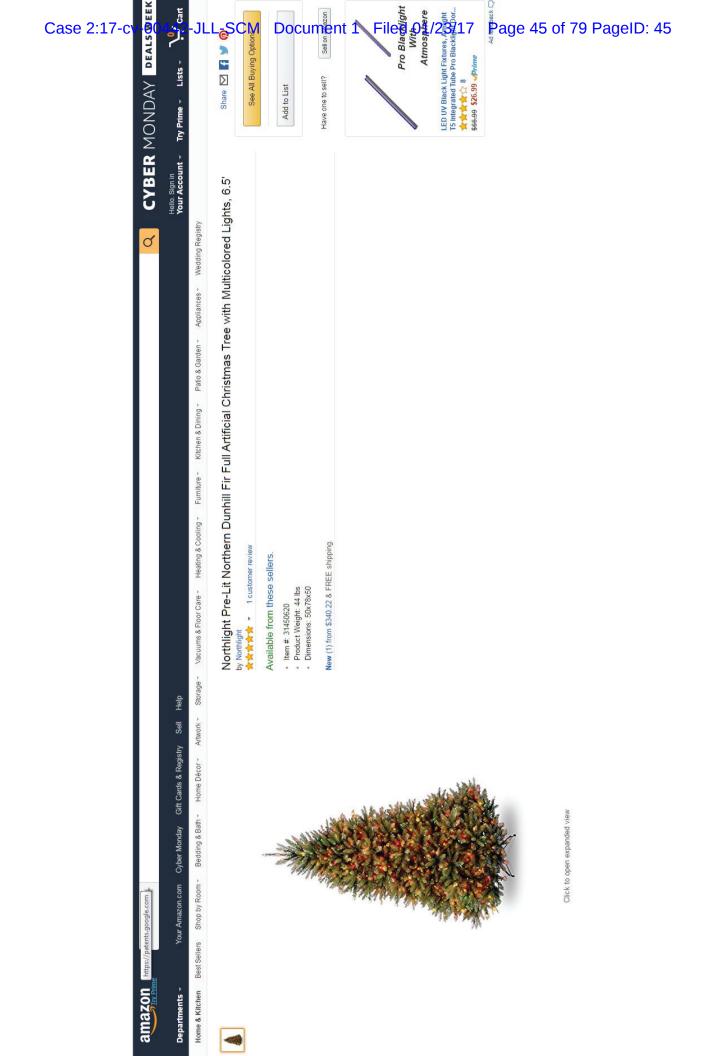
Holidays > Christmas Decorations > ... > Regular (Full) Christmas Trees > National Tree Co. > SKU: NTC2317 Share: 🖂 🔞 f 👅 </>

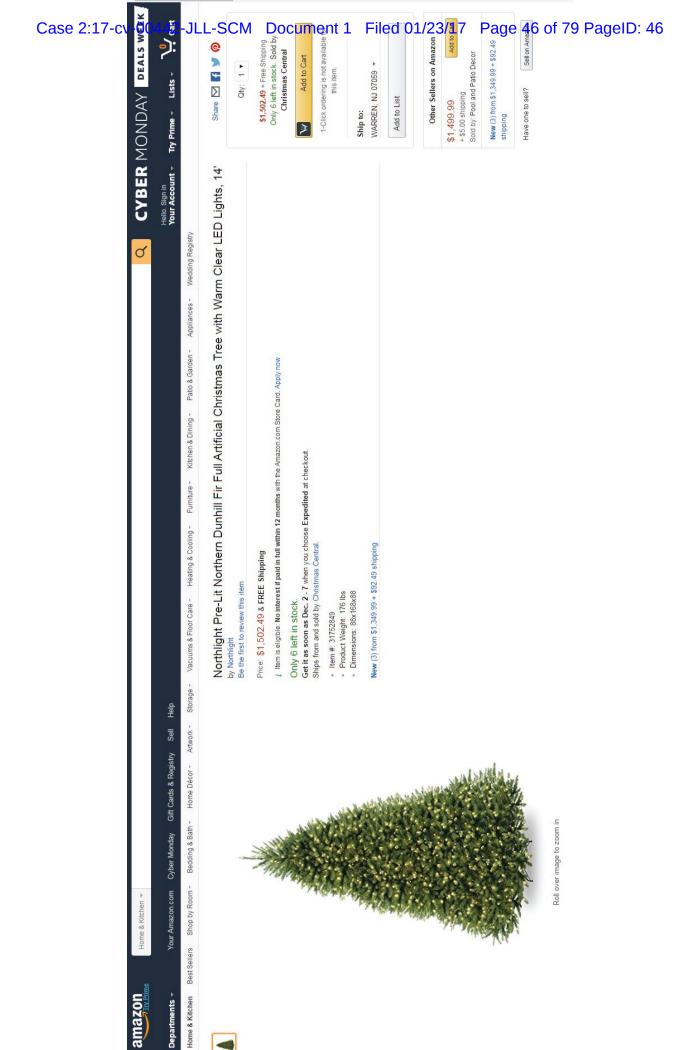
You Might Also Need











Patio & Garden Kitchen & Dining * Furniture * Heating & Cooling * Vacuums & Floor Care → Storage * Artwork -Home Décor + Bedding & Bath -Shop by Room - Back to search results for "artificial Christmas tree" Best Sellers Home & Kitchen

3 \rangle Share

See All Buying Options

Add to List

Outdoor Solar Led Light Use for 1 Pation, Fairy Garden, Home, Indo. \$20.00 \$11.90 \$70.00 \$11.90 \$70.00 \$10.

Shop Now

Roll over image to zoom in

Shop products for every room in your home from your Garage to your Kitchen.

National Tree 6 1/2-Feet Dunhill Fir Tree, Hinged, 650 Clear Lights (DUH-65LO)

by National Tree Company

| 13 customer reviews | 5 answered questions

Available from these sellers.

- Imported
- Measures 6.5 feet tall with 53" diameter
- Pre-strung with 650 UL listed clear lights and 1838 branch tips
- All metal hinged construction (branches are attached to center pole sections)
- Includes sturdy folding metal tree stand
 - Fire-resistant and non-allergenic
- Show more



New (1) from \$399.99 & FREE shipping.





Exhibit H

6 Commerce Drive, Suite 304 Cranford, New Jersey 07016-3515

Phone: 973-635-4500 Fax: 973-635-4543

www.fmnjlaw.com

November 11, 2016

Via Certified Mail, R.R.R., Ordinary Mail and Nathan@christmascentral.com

Gordon Companies, Inc. 85 Innsbruck Drive Cheektowaga, New York 14227 Attn: David Gordon/Nathan Gordon

Re: Copyright Infringement

Gentlemen:

This firm represents National Christmas Products, Inc. d/b/a National Tree Company ("NTC"). It has come to my client's attention that you are making unauthorized use of the copyrighted work of NTC, specifically, certain photographs that are used by NTC to depict NTC's products on its website and on third party websites (the "Copyrighted Photos"). By way of example, one of the Copyrighted Photos that my client uses to depict its "Dunhill Fir 7.5" Hinged Green Artificial Christmas Tree with 750 Clear Lights" is being used by you in connection with your marketing of a tree described on your website as "7.5' Pre-lit Northern Dunhill Fir Full Artificial Christmas Tree – Warm Clear Lights". This and other Copyrighted Photos also appear as depictions of your products on wayfair.com, amazon.com, walmart.com and presumably, other e-commerce sites.1

You neither asked for nor received permission to use the Copyrighted Photos. Therefore, it appears that you have willfully infringed NTC's rights under 17 USC § 101, et seq. and, are liable to NTC for substantial statutory damages, in addition to other relief available to NTC.

NTC demands that you immediately direct the operators of all websites through which your products are sold to remove the Copyrighted Photos and discontinue all inventory feeds containing same. NTC further demands that you immediately cease all other use of the Copyrighted Photos and that you deliver to the Company all unused, undistributed copies of same, or destroy such copies immediately, and that you desist from all infringement of the NTC's rights.

¹ Under separate cover, we have advised you that the use of the term "Dunhill" in connection with your marketing of artificial Christmas trees infringes upon NTC's trademark. This letter is sent to advise that in addition to the trademark infringement, you are also engaging in the unauthorized use of NTC's copyrighted work.

November 11, 2016 Page Two

NTC reserves the right to send Take-Down Notices to all website owners, website hosts and search engines (for convenience, "ISPs") pursuant to the Digital Millennium Copyright Act ("DMCA") (17 § USC 512(c)). Pursuant to the DMCA, the ISPs are required by law to remove and/or disable access to all infringing postings, pages and listings. Failure to comply with the DMCA renders the non-complying party liable for civil damages and penalties.

Your immediate compliance is demanded. Failure to comply shall force my client to take legal action.

This letter is sent without prejudice to all of our client's rights and claims, all of which are expressly reserved.

Very truly yours,

Michael D. Malloy €

MDM/aj

Exhibit I

Case 2:17-cv-00442-JLL-SCM Document 1 Filed 01/23/17 Page 52 of 79 PageID: 52

6 Commerce Drive, Suite 304 Cranford, New Jersey 07016-3515

Phone: 973-635-4500 Fax: 973-635-4543

www.fmnjlaw.com

November 11, 2016

Via Certified Mail, R.R.R., Ordinary Mail and Nathan@christmascentral.com

Gordon Companies, Inc. 85 Innsbruck Drive Cheektowaga, New York 14227 Attn: David Gordon/Nathan Gordon

Re: <u>Trademark Infringement</u>

Gentlemen:

This firm represents National Christmas Products, Inc. d/b/a National Tree Company ("NTC"), which is the owner of U.S. Federal Trademark Registration No. 4748103 relating to the trademark "Dunhill" for, inter alia, artificial Christmas trees. NTC uses this mark in the United States and around the world in conjunction with the sale of its products. The mark has been in continuous use since October 27, 1999.1

Our client has discovered that the Gordon Companies, trading as Northlight Seasonal, is intentionally trading on NTC's goodwill by using a name for its products that is confusingly similar to NTC's trademark. Your website at northlightseasonal.com prominently features NTC's registered trademark in the description of various artificial Christmas trees, wreaths and garlands. (See, e.g., "7.5 Foot Pre-Lit Northern *Dunhill* Fir Full Artificial Christmas Tree – Warm Clear Lights" at http://www.northlightseasonal.com/collections/artificial-christmas-trees/products/31752850). My client indicates that the mark is also being used to sell your products on wayfair.com, amazon.com, walmart.com and other e-commerce sites.

It is clear that your use of "Dunhill" is intended to (and actually does) confuse and misdirect customers seeking our client's goods. This activity is actionable under federal law and causes you to be liable to NTC in every state and country in which you have made sales. Your activities are unlawful and constitute unfair competition, intentional trademark infringement, trademark dilution, and false designation of origin.

¹ Under separate cover, we have advised that you are making unauthorized use of certain photographs which are the copyrighted work of NTC. This letter is sent to advise that in addition to the copyright violation, you are also infringing upon our client's registered trademark.

November 11, 2016 Page Two

Federal trademark law provides numerous remedies for trademark infringement and dilution, including but not limited to preliminary and permanent injunctive relief, money damages, disgorgement of profits, remedies for the destruction or confiscation of infringing products and promotional materials, and, where intentional infringement is shown, attorneys fees and treble money damages.

My client demands that you immediately a) cease and desist from further use of "Dunhill" in the marketing and sale of your products; b) remove all references to "Dunhill" on your website; c) discontinue all inventory feeds to e-commerce sites containing such references; d) direct the operators of all such sites to remove such references; and e) supply an accounting of profits derived by your company from the use of "Dunhill" to date. Failure to so comply shall force my client to take legal action. In this regard, a lawsuit may be filed against you seeking: (i) preliminary and permanent injunctions, (ii) money damages, (iii) compensation equal to your profits, (iv) reimbursement for attorney's fees, and (v) a court order that you compensate NTC for damage to its goodwill.

This letter is sent without prejudice to our client's rights and claims, all of which are expressly reserved.

Very truly yours,

Michael D. Malley

MDM/aj

Exhibit J

James M. Smedley LLC

The Sigma Law Group
www.sigmalawgroup.com
Forward Thinking - Client Focused

James Michael Smedley, Esq. James M. Smedley LLC 776 Mountain Blvd., STE 105 Watchung, NJ 07069 (732)564-5443

November 28, 2016

Sears Legal Intake (via Fax) 847.286.4511

Dear Sir or Madam:

I am contacting you on behalf of my client, National Christmas Products, Inc. d/b/a National Tree Company ("NTC") owner of the federally registered trademark in the name DUNHILL FIR® (U.S. Registered Trademark No. 4748103) for use with artificial Christmas trees. It has come to our attention that Gordan Companies, trading as Northlight Seasonal ("Northlight") and Vickerman ("Vickerman") are intentionally trading on NTC's goodwill and using our client's mark without permission to sell artificial Christmas trees on your website Sears.com.

Below is a sample listing of the products that NTC believes in good faith are infringing its trademark rights: (Links to the above products are included in the Annex A).

Northlight
Item # SPM11011054513
Item # SPM10664200813

Vickerman
Item # SPM3803153101
Item # SPM3803174101
Item # SPM3803108501
Item # SPM3803123601

My client has made widespread use, distribution and sale of products and services using the DUNHILL FIR® trademark. In this regard, this trademark has acquired an extensive reputation and goodwill. The DUNHILL FIR® trademark is, accordingly, also a well-known mark for all relevant purposes of trademark law.

The mark, as used on your site, bears an identical name as our client's DUNHILL FIR [®] trademarked product and services and also constitutes a reproduction or imitation thereof.

In the circumstances, Northlight's and Vickerman's use of the DUNHILL FIR® mark on your website constitutes infringement of my client's federally protected rights. A letter was sent to Northlight on or about November 11, 2016 requesting Northlight to cease and desist such lawful

776 Mountain Blvd, STE 105, Watchung, NJ 07069

P: +1(732)564-5443 F: +1(732)490-6616 use of my client's mark to compensate my client for the unlawful use, and similar procedure shall be pursued with regards to Vickerman's impermissible use.

Accordingly, and based on Northlight's and Vickerman's trademark infringement, we request you take down, block and remove their product page for the above listed products.

Please feel free to contact me directly if you have any questions regarding this request or if there is any way I can assist you in complying with this request.

Sincerely,

James Michael Smedley, Esq.

Managing Member

James M. Smedley LLC

F: +1(732)490-6616

Annex A

Northlight

http://www.sears.com/northlight-6.5'-pre-lit-northern-dunhill-fir-full/p-SPM11011054513?plpSellerId=Christmas%20Central&prdNo=10&blockNo=10&blockType=G10

http://www.sears.com/northlight-4'-pre-lit-northern-dunhill-fir-full/p-SPM10664200813?plpSellerId=Christmas%20Central&prdNo=25&blockNo=25&blockType=G25

Vickerman

http://www.sears.com/vickerman-6'-pre-lit-frosted-dunhill-fir-artificial/p-SPM3803153101

http://www.sears.com/vickerman-9'-pre-lit-frosted-dunhill-fir-artificial/p-SPM3803174101

http://www.sears.com/vickerman-3'-pre-lit-frosted-dunhill-fir-artificial/p-SPM3803108501

http://www.sears.com/vickerman-4.5'-pre-lit-frosted-dunhill-fir-artificial/p-SPM3803123601

F: +1(732)490-6616

From: RingCentral
To: Honeah Mangione

Subject: Fax Message Transmission Result to +1 (847) 2864511 - Sent

Date: Monday, November 28, 2016 3:36:21 PM

Fax Transmission Results

Here are the results of the 4-page fax you sent from your phone number (732) 564-5443, Ext. 105:

 Name
 Phone Number
 Date and Time
 Result

 +1 (847) 2864511
 Monday, November 28, 2016 at 03:35 PM
 Sent

Your fax(es) included the following file(s), which were rendered into fax format for transmission:

File Name Result

TakeDown Letter (Sears).pdf Success

Exhibit K

James M. Smedley LLC



James M Smedley LLC 776 Mountain Blvd. STE 105 Watchung, NJ 07069 (732)564-5443

Walmart Legal (via Fax) 479.277.5991

Dear Sir or Madam:

I am contacting you on behalf of my client, National Christmas Products, Inc. d/b/a National Tree Company ("NTC") owner of the federally registered trademark in the name DUNHILL FIR® (U.S. Registered Trademark No. 4748103) for use with artificial Christmas trees. It has come to our attention that Gordan Companies, trading as Northlight Seasonal ("Northlight") is intentionally trading on NTC's goodwill and using our client's mark without permission to sell artificial Christmas trees on your website Walmart.com.

Below is a sample listing of the products that NTC believes in good faith are infringing its trademark rights: (Links to the above products are included in the Annex A).

Item No: 39142729	Item No: 39129663	Item No: 47756879
Item No: 39130321	Item No: 39130274	Item No: 39130278
Item No: 39129661	Item No: 41293010	Item No: 47420881
Item No: 45041889	Item No: 39191696	Item No: 39141814
Item No: 47420956		

My client has made widespread use, distribution and sale of products and services using the DUNHILL FIR® trademark. In this regard, this trademark has acquired an extensive reputation and goodwill. The DUNHILL FIR® trademark is, accordingly, also a well-known mark for all relevant purposes of trademark law.

The mark, as used on your site, bears an identical name as our client's DUNHILL FIR [®] trademarked product and services and also constitutes a reproduction or imitation thereof.

In the circumstances, Northlight's use of the DUNHILL FIR® mark on your website constitutes infringement of my client's federally protected rights. A letter was sent to Northlight on or about November 11, 2016 requesting Northlight to cease and desist such lawful use of my client's mark to compensate my client for the unlawful use.

776 Mountain Blvd, STE 105, Watchung, NJ 07069 P: +1(732)564-5443

F: +1(732)490-6616

Accordingly, and based on Northlight's trademark infringement, we request you take down, block and remove Northlight's product page for the above listed products.

Please feel free to contact me directly if you have any questions regarding this request or if there is any way I can assist you in complying with this request.

Sincerely,

James Michael Smedley, Esq.

Managing Member

James M. Smedley LLC

F: +1(732)490-6616

Annex A

https://www.walmart.com/ip/9-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Clear-Lights/39142729

https://www.walmart.com/ip/12-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Multi-Color-Lights/39130321

https://www.walmart.com/ip/10-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Unlit/39129661

https://www.walmart.com/ip/12-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Unlit/39129663

https://www.walmart.com/ip/4-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Clear-Lights/39130274

https://www.walmart.com/ip/6.5-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Unlit/41293010

https://www.walmart.com/ip/12-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Clear-Lights/39191696

https://www.walmart.com/ip/7.5-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Unlit/39141814

https://www.walmart.com/ip/9-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Warm-Clear-LED-Lights/47756879

https://www.walmart.com/ip/6.5-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Clear-Lights/39130278

https://www.walmart.com/ip/4-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Warm-Clear-LED-Lights/47420881

https://www.walmart.com/ip/10-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Clear-Lights/45041889

https://www.walmart.com/ip/6.5-Pre-Lit-Northern-Dunhill-Fir-Full-Artificial-Christmas-Tree-Warm-Clear-LED-Lights/47420956

From: RingCentral
To: Honeah Mangione

Subject: Fax Message Transmission Result to +1 (479) 2775991 - Sent

Date: Monday, November 21, 2016 4:49:27 PM

Fax Transmission Results

Here are the results of the 4-page fax you sent from your phone number (732) 564-5443, Ext. 105:

 Name
 Phone Number
 Date and Time
 Result

 +1 (479) 2775991
 Monday, November 21, 2016 at 04:48 PM
 Sent

Your fax(es) included the following file(s), which were rendered into fax format for transmission:

File Name Result

TakeDown Letter.pdf Success

Exhibit L

From: <u>James Smedley</u>
To: <u>Honeah Mangione</u>

Subject: Fwd: Gordon Companies / National Christmas Products TM / C Matter

Date: Tuesday, November 29, 2016 3:46:42 PM

Kind regards,

James Michael Smedley, Esq. Managing Member The Sigma Law Group James M. Smedley LLC www.sigmalawgroup.com

Direct Dial: (732)481-0587

O:(732)564-5443 F:(732)490-6616

ATTORNEY-CLIENT PRIVILEGED AND/OR CONFIDENTIAL INFORMATION

This transmission contains information from James M. Smedley LLC that is privileged and/or confidential. The information is intended to be for the sole use of the individual or entity named on this transmission. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or use of the contents of this transmission is strictly prohibited. If you have received this transmission in error, please notify James M. Smedley LLC immediately so that we can arrange for the retrieval of the original documents at no cost to you. Alternatively, notify the sender by replying to this transmission and delete the message without disclosing it. Thank you.

----- Forwarded message -----

From: Walbesser, Jordan < JWalbess@hodgsonruss.com>

Date: Mon, Nov 28, 2016 at 5:00 PM

Subject: Gordon Companies / National Christmas Products TM / C Matter

To: James Smedley <<u>james.smedley@sigmalawgroup.com</u>>
Cc: Dave Gordon <<u>dave@christmascentral.com</u>>, Nathan Gordon

<<u>nathan@christmascentral.com</u>>, "Joyce, Daniel" <<u>DJoyce@hodgsonruss.com</u>>

Dear James:

Thank you for your phone call last week regarding National Tree Company's (NTC) cease and desist letter to Gordon Companies Inc. (Gordon). We have now had an opportunity to complete our investigation of this matter.

As a result, Gordon has made the business decision to replace any allegedly infringing product photos as well as remove all references to NORTHERN DUNHILL from the NorthlightSeasonal.com website and Gordon's sales channels on Wayfair.com, Amazon.com, Walmart.com, and other e-commerce sites.

We note that NTC's trademark registration is for DUNHILL FIR. Our client was surprised to learn that DUNHILL FIR was a registered trademark. None of NTC's catalogs or marketing material indicate that DUNHILL FIR is a registered trademark, for example, through use of the (R) symbol. Our client believed that "Dunhill Fir" was a non-infringing tree name, like Douglas Fir.

Regardless, because the NORTHERN DUNHILL name is of no real significance to Gordon, the remedial action was done not as an admission of wrongdoing but as an efficient way to resolve a nonissue. Gordon has merely been a reseller of goods originating in China and had every reason to believe the products were non-infringing.

NTC and Gordon have a long history of doing business together. In fact, Gordon continues to drop ship products for NTC during this holiday season. We trust that this resolves the matter in a way that allows NTC and Gordon can continue to do business together.

Best regards,

Jordan

Jordan L. Walbesser

Senior Associate

Hodgson Russ LLP

Office: 716.848.1663 | Mobile: 716.640.0532

The Guaranty Building | 140 Pearl Street, Suite 100 | Buffalo, NY 14202

<u>Twitter</u>| <u>vCard</u> | <u>Bio</u> | <u>LinkedIn</u>

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Exhibit M

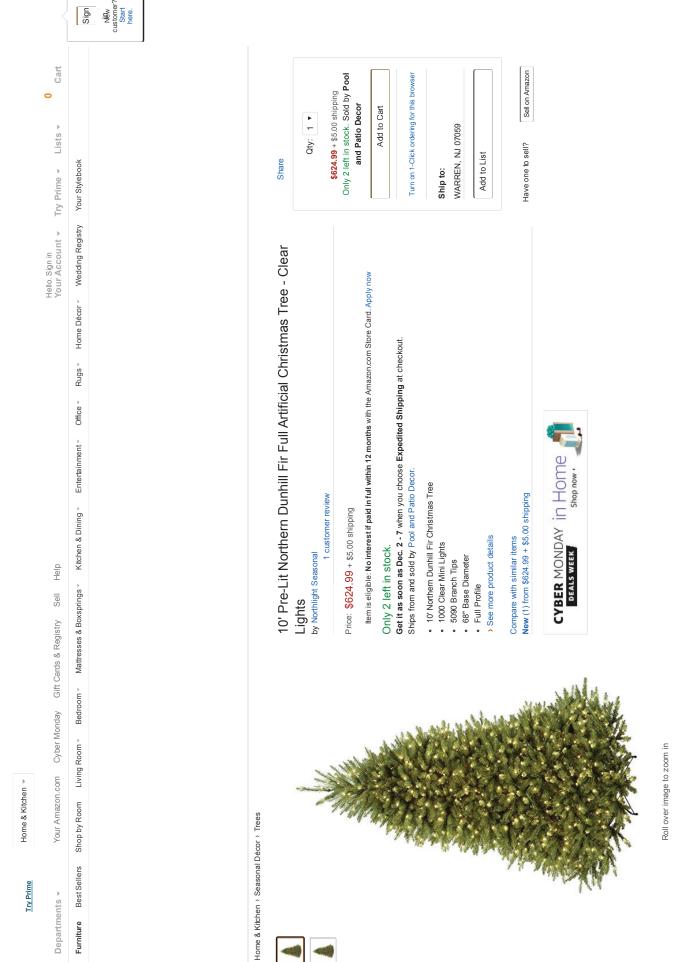






Exhibit N



12' Pre-lit Northern Dunhill Fir Full Artificial Christmas Tree - Warm Clear LED Lights

★★★★ Write a review



\$1,203.74

List price \$1,499.99 Save \$296.25

Sold & Shipped by Christmas Central







save \$156.25 9' Pre-Lit Northern Pine Full Artificial...



save \$30.25 4' Pre-Lit Noble Fir Full Artificial Christmas...



\$26.15 list price \$34.13 save \$7.98 NorthLight 2 ft. Pre-Lit Snow White Artificial...



Vickerman Pre-Lit 2' Imperial Pine...



NorthLight 4 ft. Pre-Lit Whimsical Red Tinsel...



Reduced Price

save \$7.25 3' Pre-Lit Whimsical Champagne Artificial...

About this item

Customer Reviews

Item Recommendations

Policies & Plans

Exhibit O

We found **0 results** for **"northlight pre-lit Northern Dunhill Firm LED lights 4"**Use fewer keywords or try these instead

"northlight Northern LED lights" See all 15 results...



Northlight Pre-Lit Northern Dunhill Fir Full Artificial Christmas Tree with Warm Clear LED Lights, 9' by Northlight

\$53936

More Buying Choices \$539.36 new (2 offers)

FREE Shipping on eligible orders



Northlight Pre-Lit Northern Dunhill Fir Full Artificial Christmas Tree with Warm Clear LED Lights, 12' by Northlight

\$1,20249

Only 16 left in stock - order soon.

More Buying Choices \$1,199.99 new (2 offers)

FREE Shipping on eligible orders



Northlight LED Lighted Menorah Hanukkah Yard Art Decoration with Cool White Lights, 24" by Northlight

\$99.00 new (2 offers)





36" Pre-Lit Northern Pine Artificial Christmas Wreath -Warm Clear LED Lights by Northlight

\$7849

More Buying Choices \$75.99 new (2 offers)

FREE Shipping on eligible orders

"northlight pre-lit Northern" See all 36 results...



Northlight Pre-Lit Northern Dunhill Fir Full Artificial Christmas Tree with Multicolored Lights, 4' by Northlight

\$143.50 new (1 offer)

★★★★☆ ▼5



Northlight Pre-Lit Northern Dunhill Fir Full Artificial Christmas Tree with Clear Lights, 6.5' by Northlight

\$20750

More Buying Choices \$207.50 new (2 offers)

FREE Shipping on eligible orders

★ជំជំជំជំ + 1



Northlight Pre-Lit Northern Dunhill Fir Full Artificial Christmas Tree with Clear Lights, 12' by Northlight

\$752¹⁸

Only 11 left in stock - order soon.

More Buying Choices \$752.18 new (2 offers) \$450.00 used (1 offer)

FREE Shipping on eligible orders



Northlight Pre-Lit Northern Dunhill Fir Full Artificial Christmas Tree with Clear Lights, 9' by Northlight

\$46201

More Buying Choices \$462.01 new (2 offers)

FREE Shipping on eligible orders

"pre-lit Northern LED lights" See all 43 results...

Exhibit P

find a store store ads gift cards registry my account no saved items recommendations track order customer service Your Store: Woodbridge Ctr my bag enter search term or web id \$0.00 change store for the home bed & bath window appliances women lingerie men juniors kids baby shoes handbags jewelry gifts sephora clearance IN STORE & ONLINE • ENDS 12/14 • GET COUPON > ONLINE ONLY • ENDS 12/14 FREE SHIPPING OVER \$49 OR TO STORES OVER \$25 WHEN YOU SPEND \$25 WITH YOUR JCPENNEY CREDIT CARD NO CODE REQUIRED CODE: WESHOP46 CODE: TOSAVE46 CODE: TOSAVE46 **GET DETAILS** > *CREDIT OFFERS SUBJECT TO CREDIT APPROVAL. EXCLUSIONS & DETAILS > jcpenney > back to search results 9' x 64" Pre-Lit Northern Dunhill \$2,015 Fir Full Artificial Christmas Tree -Multi-Color LED Lights" **** Write the First Review web ID: 0452928 Q&A Ask A Question HELPFUL INFORMATION QUANTITY **Returns Policy** TRUCK DELIVERY ITEM See details PRODUCT DESCRIPTION Ship to Home · Assembly: Assembly Required · Use: Indoor/Outdoor Online only, not available in · Assembled With: 100 Not Applicable · Care: Not Applicable, Gentle · Country of Origin: Imported **ADD TO BAG** SAVE FOR LATER ADD TO REGISTRY YOU MAY ALSO LIKE PEOPLE WHO VIEWED THIS ULTIMATELY PURCHASED Kurt Adler 6 Ft. Pre-Lit Green Kurt Adler 6 Ft. Pre-Lit LED 7' Pre-Lit Slim Spruce Tree Storage Bag North Pole Trading Co. 6.5' Pine Tree Green Pine Tree Christmas Tree Dakota Pre-Lit Pine Tree \$40 original \$400 original \$400 original \$280 original \$240 original \$19.99 sale \$199.99 sale \$199.99 sale \$139.99 sale \$71.99 sale ★★★★★ (12) **★★★**★★ (21) ***** (5) **Customer Reviews** Q&A **** Be the first to write a review **CUSTOMERS ALSO BOUGHT** Feedback

Exhibit Q



7.5 Ft. Northern Dunhill Fir Full Artificial Christmas Tree, Unlit

Item # D016077S **Online Only**



Write A Review

\$199.99 \$399.99





Description

This pretty, full-profile Northern Dunhill Fir tree features perfectlyshaped tapered tips that are a medium green color and have a natural, lush look and feel.

Details:

- Unlit
- 2,514 tips
- 1.75" wide tips
- Full profile tree
- Flame retardant
- Hinged branch construction
- For indoor use only
- Includes black metal tree stand
- 7.5 ft. high (from base of stand to top of tree)
- 56" base diameter (at the widest point)
- Materials: PVC/metal
- 52 lbs.

View Less Details

You May Also Like

Exhibit R

DESCRIPTION: 7.5' NORTHERN DUNHILL TREE CASE QUANTITY: 1

Carton // of 200

Northlight

wayfair Secure Checkout &

Questions? 866-263-8325 Ref #47-88-81-35-10

My Order sdit () item)

Product Cost

Shipping

Tox

Total



2. Shipping

3. Payment



\$199.99

FREE

\$14.00

\$213.99

You save \$50.00 (20%)

Almost there! Review and place your order.

Shipping Information change

Sal Puleo 681 Montgomery Rd Hillsborough, NJ 08844-1303 United States 9082627020

Order Details

Phone Number *: 9082627020

Billing Information

Payment Method:

PayPal® change

Northlight 7.5' Northern Innsbruk Pine Full Artificial Christmos Tree SKU #: NLGT2093

Gry.t Change Bemave

Price: \$199.99

(to ensure delivery)

* FREE Ground - Get it by Mon, Dec 19 Expedited - Get it by Fri. Dec 16

Signess - Ger it by Thu, Dec 15

Use a gift card/promotion

Apply a gift card or promo cade

Purchasing for a client or your business? Yes No.

Danate to Habitat for Humanity

\$1 *

Add a gift message

By placing this order, you are agreeing to our terms and conditions

Our Renal Brands